

REMARKS

Claims 1, 7 to 14, 18 to 19 and 21 to 25 are pending.

As requested in Applicant's April 14, 2003 REQUEST FOR ACKNOWLEDGEMENT OF CONSIDERATION OF DISCLOSED INFORMATION, the Examiner is requested to initial and return to the undersigned a copy of Form PTO-1449 listing the U. Rodenerck et al. reference. A second copy of the Form is enclosed with this Amendment.

I... OBJECTION TO THE CLAIMS

Claim 1 has been amended to delete the period and "space." The objection to claim 1 should be withdrawn.

II. 35 U.S.C. §112, SECOND PARAGRAPH REJECTION OF CLAIMS 1, 3 TO 4, 6 TO 15 AND 18 TO 19

Claims 1, 3 to 4, 6 to 15 and 18 to 19 were rejected under 35 U.S.C. §112, second paragraph.

The Office Action rejects claims 3 and 4 as vague and indefinite in including reference to canceled claim 2. Claims 3 and 4 have been canceled.

The Office Action states that

Claim 1 (line 10) and 18 (lines 9-11) recite the phrase "a best case set of factors" and claim 18 (line 1) recites the phrase "a best case set of experiments" which are vague and indefinite. It is unclear what criteria are used to determine that a case set is the best. Clarification of the metes and bounds of the claim via clearer claim wording is requested. Claims 6-15 and 19 are also rejected due to their direct or indirect dependency from claims 1 and 18. Claim 8 is also rejected due to a similar issue of the "best set of factors" being selected.

May 12, 2003 Office Action page 3.

And further, the Office Action at pages 3 to 4 states.

Claim 3 recites the phrase "array of reactants" which is vague and indefinite. It is unclear if this phrase is referring to a microarray

containing reactants or to a group of a large number of elements, in this case, reactants. Clarification of this phrase is required. This rejection is reiterated from the previous Office action, mailed 1/27/03, and unargued by Applicant.

May 12, 2003 Office Action pages 3 to 4.

These bases for 35 U.S.C. §112, second paragraph rejections are incorrect for the same reasons that the PTO's previous Office Action rejection based on "factor," was incorrect. A quick search of the PTO patent database reveals 1840 patents that have used the term "best case," 22 patents that have used the term "array of reactants" and 260,450 patents that have used "array." Merriam Webster's Collegiate Dictionary, 10th Ed., p. 108 (1993) defines the term "best case" as "being, relating to, or based on a projection of future events that assumes only the best possible circumstances." The Dictionary, page 64 defines "array" as "a group of elements forming a complete unit." The terms are common, ordinary and well-known English-language terms. The specification provides multiple examples of determining best case catalysts based on TON (catalyst turnover number and multiple examples of "array(s) of reactants." From well known meanings and the examples of the specification, the terms apprise those skilled in the art of the claim scope.

The PTO is specifically requested to withdraw this rejection or to cite its authority for propositions that claims fail to "particularly point out or distinctly claim" where the claims fail to recite "criteria... used to determine that a case set is best" or because a term could encompass both a "microarray containing reactants or... a group of a large number of elements."

As pointed out in Applicant's February 20, 2003 Amendment, 35 U.S.C. §112, second paragraph does not prohibit terms that encompasses more than one type (criteria and types of arrays). Otherwise, 35 U.S.C. §112, second paragraph would prohibit generic claims. 35 U.S.C. §112, second paragraph does not prohibit generic claims. 35 U.S.C. §112, second paragraph only requires language to apprise one skilled in the art. Use of the terms "best case set of factors" and "array of reactants" meet this requirement.

The rejections of claims 1, 3 to 4, 6 to 15 and 18 to 19 under 35 U.S.C. §112,

second paragraph should be withdrawn.

III. 35 U.S.C. §103(A) REJECTION OF CLAIMS 1, 3 TO 4 AND 6 TO 14 UNDER 35 U.S.C. §103(A) OVER REDDINGTON ET AL., CHAUDHARI ET AL., AGRAFIOTIS ET AL. AND NOVA ET AL.

Claims 1, 3 to 4 and 6 to 14 were rejected under 35 U.S.C. §103(a) over Reddington et al., Chaudhari et al., Agrafiotis et al. and Nova et al. Claim 15 was not rejected. The present Amendment amends independent claim 1 to be the same as claim 15 with terms definitions and rewritten in independent form. Claim 1 as rewritten should be allowable. Claims 3 to 4 and 6 to 14 depend from claim 1 and should be allowable. The rejection of claims 1, 3 to 4 and 6 to 14 under 35 U.S.C. §103(a) over Reddington et al., Chaudhari et al., Agrafiotis et al. and Nova et al. should be withdrawn.

Applicant vigorously traverses the rejection of claims 1, 3 to 4 and 6 to 14 under 35 U.S.C. §103(a) over Reddington et al., Chaudhari et al., Agrafiotis et al. and Nova et al. The rejection is based on improper combinations of references without the motivation to combine required by *In re Lee*, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002). Additionally, even if improperly combined, the references do not make out a prima facie case of obviousness. See *In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995). However, Applicant has amended the claims including canceling claims, to gain a quick allowance in view of the fact that claim 15 was not rejected over the art. However, if the current amendments and 35 U.S.C. §112, second paragraph arguments do not place this case in condition for allowance, Applicant retains the right to restore all canceled claims to place the claims back into their original form and to argue the impropriety of the current rejections.

IV. ALLOWABLE CLAIMS AND RESTRICTION REQUIREMENT

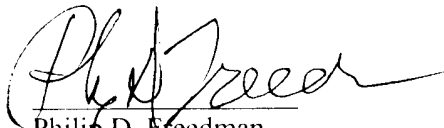
Claims 18 and 19 were not rejected under 35 U.S.C. §103(a). Claim 18 is an allowable generic claim. Hence, the restriction requirement should be withdrawn for the reasons specified in Applicant's February 20, 2003 Amendment. See MPEP 809.04. Claims 21 to 22 depend from claim 18 and should also be allowable.

V. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1, 7 to 14, 18 to 19 and 21 to 25 are allowable. Reconsideration and allowance are requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, she is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Attachment:
Form 1449